Supreme Court, U.S.
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No. ____

In The

SUPREME COURT OF THE UNITED STATES

October Term, 1996

ENERCON INDUSTRIES CORPORATION,
and AHLBRANDT SYSTEMS, INC.,

Petitioners,

v.

PILLAR CORPORATION, PILLAR TECHNOLOGIES,
INC., and PILLAR TECHNOLOGIES, L.P.,

Respondents.

Petition for Writ of Certiorari
To The United States Court of Appeals
For The Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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62 pp

QUESTIONS PRESENTED

1. Is an interlocutory order of a district court that dismisses the complaint, including its prayer for preliminary and permanent injunctions, after trial of liability in a patent infringement action an "Interlocutory order . . . refusing . . . injunctions" within the meaning of 28 U.S.C. §1292(a)(1)?

2. Must the plaintiff appealing from the order described above show that the order might have a serious, perhaps irreparable, consequence and that the order can be effectually challenged only by immediate appeal to have a right of appeal under 28 U.S.C. §1292(A)(1)?

3. In construing a patent claim for the purpose of determining whether the claim is infringed, there being no definitions in the specification giving any of the words meanings different from their dictionary definitions, may the district court depart from the plain meaning of the claim language to avoid finding an infringement?

TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED	i
TABLE OF AUTHORITIES	iv
OPINIONS BELOW	1
JURISDICTION	1
STATUTORY PROVISIONS INVOLVED	1
STATEMENT	2
I. The Court of Appeals Decision to be Reviewed	2
II. Proceedings Below	3
III. District Court's Decision and Order	4
REASONS FOR GRANTING THE WRIT	7
I. The Decision of the Court of Appeals for the Federal Circuit Conflicts with Decisions of the Court of Appeals for the Seventh Circuit and other Circuits	7
II. The Decision of the Court of Appeals Conflicts with 28 U.S.C. §1292(a)(1) and This Court's Precedents	10
III. The Decision of the District Court Conflicts with Precedents of This Court	14
IV. The Questions Presented Are Important	17
CONCLUSION	19
APPENDIX 1, Opinion of the Court of Appeals	
APPENDIX 2, Decision and Order of the District Court	

TABLE OF AUTHORITIES

CASES

Atwood Turnkey Drilling, Inc. v. Petroleo Brasileiro, S.A., 875 F.2d 1174 (5th Cir. 1989), *cert. denied*, 493 U.S. 1075, 110 S.Ct. 1124, 107 L.Ed.2d 1030 (1990) . . . 10

Baltimore Contractors, Inc. v. Jacob H. Bodinger, 348 U.S. 176,182, 75 S.Ct. 249,253 (1954) 12,13,17

Botanic v. Becton Dickinson & Co., __ U.S. __, 108 S.Ct. 1717, 100 L.Ed.2d 178 (1988). . . . 18

Cable Holdings of Battlefield, Inc. v. Cooke, 764 F.2d 1466.1471 (llth Cir. 1985). 10

Carson v. American Brands, Inc., 450 U.S. 79, 101 S.Ct. 993, 67 L.Ed.2d 59 (1981) 3,8,10,11,12,13,17

Cohen v. Board of Trustees of the Univ. of Medicine & Dentistry, 867 F.2d 1455 (3rd Cir. 1989) 10

Feinstein v. Space Ventures, Inc., 989 F.2d 49 (1st Cir 1993). 10

Graff v. City of Chicago, 986 F.2d 1055 (7th Cir. 1993). . . . 9

Holmes v. Fisher, 854 F.2d 229 (7th Cir. 1988). 8,9,10,18

I.A.M. Nat'l Pension Fund Benefit Plan A v. Cooper Indus., Inc., 789 F.2d 21 (D.C.Cir.) *cert. denied*, 479 U.S. 971, 107 S.Ct.473, 93 L.Ed.2d 417 (1986) 10

James v. Campbell, 104 U.S. 356. 15

Keystone Bridge Company v. Phoenix Iron Company, 95 U.S. 274, 24 L.Ed. 344 (1877) 14,15

Markman v. Westview Instruments, Inc., 517 U.S. ___, ___ S.Ct. ____, ___ L.Ed. ____, 64 U.S.L.W. 4263, 1996 U.S. Lexis 2804 (1996) 4

Merrill v. Yoemans, 94 U.S. 568, 24 L.Ed. 235 (1876) 14

Railroad Co. v. Mellon, 104 U.S. 112, 26 L.Ed. 639 (1881) . 15

Shee Atika v. Sealaska Corp., 39 F.3d 247 (9th Cir. 1994) 9

Shanferoke Coal & Supply Corp. of Delaware v. Westchester Service Corp., 293 U.S. 449, 55 S.Ct. 313, 79 L.Ed.583 13

Tapeswitch Corporation of American v. Recora Co., Inc., 527 F.2d 1013 (7th Cir. 1976) 9

Tri-State Generation & Transmission Ass'n Inc. v. Shoshone River Power, Inc., 874 F.2d 1346 (10th Cir. 1989) . 10

United States V. Bayshore Associates, Inc., 934 F.2d 1391 (6th Cir. 1991) 10

White v. Dunbar, 116 U.S. 47, 7 S.Ct. 72 (1886) 15,18

Winans v. Denmead, 15 How. 330, 14 L.Ed. 717 (1854) ... 14,15

Woodard v. Sage Products, Inc., 818 F.2d 841, 2 USPQ2d 1649 (Fed. Cir. 1987) ..... 2,3,8, ... 9,10,11,12,17,18

STATUTES

28 U.S.C. §1254(a)(1) 1

28 U.S.C. §1292(a)(1) ..... i, ii,1,2,3,4,8 ..... 9, 10, 11, 12, 13

28 U.S.C. §1292(c)(1) 2,16

28 U.S.C. §1292(c)(2) 1,2,3,4

35 U.S.C. 281 12

35 U.S.C. 283 12

OTHER AUTHORITIES

16 Federal Practice and Procedure §3924 (1977 & 1978 Supp.) 8

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ENERCON INDUSTRIES CORPORATION,
and AHLBRANDT SYSTEMS, INC.,

Petitioners,

v.

PILLAR CORPORATION, PILLAR TECHNOLOGIES, INC., and PILLAR TECHNOLOGIES, L.P.,

Respondents.

Enercon Industries Corporation and Ahlbrandt Systems, Inc. respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit and the Decision and Order of the United States District Court for the Eastern District of Wisconsin in this case.

OPINIONS BELOW

The opinion of the court of appeals (App. 1 infra, 1-7) is reported at 105 F.3d 1437. The opinion of the district court (App. 2, infa. 1-26) is unreported.

JURISDICTION

The court of appeals entered its judgment on January 31, 1997. The jurisdiction of this Court is invoked un 28 U.S.C. §1254(1).

STATUTORY PROVISIONS INVOLVED

28 U.S.C. §1292(a)(1) providing in pertinent part ". . . the courts of appeals shall have jurisdiction of appeals from: (1) Interlocutory orders of the district courts of theUnited States, . . . refusing . . . injunctions . . .

28 U,S,C, §1292(c) "The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction —

(1) of an appeal from an interlocutory order . . . described in subsection (a) . . . of this section in any case over which the court would have jurisdiction of an appeal under section 1295 of this title;

STATEMENT

I. Court of Appeals Decision To Be Reviewed.

Enercon[1] appealed to the Court of Appeals for the Federal Circuit from the interlocutory order of the District Court for the Eastern District of Wisconsin dismissing Enercon's Amended Complaint, which alleges patent infringement and prays for damages and preliminary and permanent injunctions, the counterclaims having been stayed for later trial. The patent case was bifurcated for trial to result in a judgment final except for accounting of damages, to be appealable under 28 U.S.C. §1292(c)(2). The preliminary injunction was urged to prohibit future infringement pending a protracted accounting for damages and trial of the counterclaims.

Enercon's submissions to the Court of Appeals asserted and argued the Court of Appeals' jurisdiction under 28 U.S.C. §1292(a)(1) over the District Court's interlocutory order refusing Enercon's prayer for preliminary and permanent injunctions. Pillar's briefs did not oppose jurisdiction. During oral argument, in response to a question from the bench, Pillar's counsel stated that Pillar agreed with Enercon that the Court of Appeals has jurisdiction over Enercon's appeal.

Nevertheless, in the decision, review of which is now sought, the Court of Appeals, ruling that "In *Woodard* we considered a case virtually identical to the case at hand[]" App.1 p. 4, dismissed Enercon's appeal claiming that it lacked jurisdiction. App.1,p. 7. Enercon relied for jurisdiction on the plain meaning of 28 U.S.C.

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[1]The petitioners, referred to here as "Enercon," are Enercon Industries Corporation and Ahlbrandt Systems, Inc., who were plaintiffs in the District Court and Appellants in the Court of Appeals.

§1292(a)(1), and also contended that this case satisfies the conditions for appealability enunciated in the *en banc* decision of the Court of Appeals in *Woodard v. Sage Products, Inc.*, 818 F.2d 841, 2 USPQ2d 1649 (Fed. Cir. 1987). The *Woodard v. Sage Products, Inc.* decision purports to apply this Court's decision in *Carson v. American Brands,* Inc., 450 U.S. 79, 101 S.Ct. 993, 67 L.Ed.2d 59 (1981) to interlocutory decisions in patent infringement cases that dismiss complaints praying for preliminary and permanent injunctions.

The Court of Appeals' decision does not explain why the District Court's dismissal of Enercon's Amended Complaint is not an "Interlocutory order[s]. . . refusing injunctions" appealable under 28 U.S.C. §1292(a)(1).

II. Proceedings Below.

On July 18, 1986, two years after U.S. Patent No. 4,446,110 issued on May 1, 1984, Enercon sued Respondent, Pillar,[2] for infringement of it. The prayer for relief in Enercon's Complaint prays for damages and both preliminary and permanent injunctions. Pillar's Answer denied infringement, validity and enforceability of the patent, and Pillar filed five counterclaims, two alleging antitrust violations and three alleging unfair competition claims.

Early in the proceedings, the parties stipulated to bifurcation of the case and trial of liability first to a "judgment . . . which would otherwise be appealable to the Court of Appeals for the Federal Circuit and is final except for an accounting." 28 U.S.C. §1292(c)(2) This was done to preserve the right of appeal following trial of liability and before a protracted accounting for damages. At the same time the parties also stipulated to stay proceedings on the counterclaims until conclusion of Enercon's patent case. Pillar has contended that validity and enforceability, or lack thereof, of the patent in suit is important to some or all of its counterclaims.

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[2] The respondents here referred to as "Pillar" are Pillar Corporation, Pillar Technologies, Inc., and Pillar Technologies, L.P., who were defendants in the District Court and appellees in the Court of Appeals.

Trial of the liability portion of the patent infringement action finally proceeded on July 12, 1993, and concluded on July 16, 1993. The issues presented to the District Court for decision were infringement and validity of Claim 6, and enforceability of the patent. To limit and clarify the issues further, the parties stipulated that, of the two embodiments of the invention disclosed and claimed in the patent, Pillar did not make, use or sell the second embodiment shown in Fig. 2 of the patent, and was charged with infringing only claims covering the first embodiment shown in Fig. 1 of the patent.

On June 15, 1995, District Court entered its Decision and Order on the liability portion of the patent action, which labors to justify limiting Claim 6 to cover only the Second embodiment of the invention. Then, on the parties' stipulation that Pillar had not made, used or sold the second embodiment, the District Court's Decision and Order holds that Pillar did not infringe Claim 6. The District Court ordered that Enercon's ". . . Amended Complaint is dismissed with prejudice." App. 2, p.26. The District Court did not apply Claim 6 to Pillar's accused products and did not address either validity or enforceability of the patent.

Within 10 days after entry of that Decision and Order Pillar moved to alter and amend it by adding decisions of both the validity and enforceability issues. On November 16, 1995, the District Court denied Pillar's motion.

On December 14, 1995, Enercon filed its Notice of Appeal to the Court of Appeals for the Federal Circuit from the District Court's Decision and Order as "Interlocutory orders . . . refusing injunctions . . ." under 28 U.S.C. 1292(1)(a).

III. The District Court's Decision and Order To Be Reviewed.

The District Court's Decision and Order involves only a single issue of law, to wit: what is the correct interpretation of the last six words in Claim 6 of U.S. Patent No. 4,446,110. Cf. *Markman v. Westview Instruments, Inc.*, 517 U.S. ___, ___ S.Ct. ____, ___ L.Ed. ____, 64 U.S.L.W. 4263, 1996 U.S. Lexis 2804 (1996). The entire final element of Claim 6 is "and in which part of the cooling air flow **is passed through said brush electrode.**" [emphasis

added] But the District Court's Decision and Order "construes" the words in bold face to require — is passed ". . . through the longitudinal space within the single electrode"(App 2, pp. 12) and "this requires a hollow electrode." *Id.* pp. 24, 25.

Little factual background is needed to put this issue in context. U.S. Patent No. 4,446,110 relates to what is called a "corona treater station." A corona treater station is an apparatus used to subject the surface of a material, such as a plastic sheet material, to an intense electrical discharge called a "corona" to alter its chemical structure so that it will accept and hold printing inks or adhesives. Corona treating thus allows the use of plastic in, for example, wrapping and packaging, laminates of all sorts, photographic film, and the like.

The corona discharge is created on principles similar to those of the spark plug in an automobile engine. The spark plug has two bare copper electrodes separated by a narrow air gap, one of which is grounded to the engine block, and the other is connected to the distributor which directs a high voltage charge to it to break down the air gap with an arc discharge that ignites the fuel in the cylinder.

The corona treater station shown in the patent in suit also provides a narrow — about 1/16th inch — air gap between a high voltage electrode called the "brush electrode" and a grounded electrode, which is a bare metal roller. But the brush electrode is coated with a dielectric, such as quartz or ceramic, that blocks any arc discharge. This creates an intense electric field between the electrodes that ionizes the air molecules in the air gap. The air ions, which are electrically charged molecules or atoms, carry the electrical energy between the electrodes, producing the purple glow and buzzing sound characteristic of a corona discharge.

To spread the corona discharge evenly across the entire surface of the plastic film to be treated, the grounded metal roller and the brush electrode are at least as long as the film is wide. The grounded metal roller also supports the film while it is in the corona treater station. The high voltage brush electrode is a rod-shaped structure mounted parallel with the surface of the grounded roller and spaced about 1/16 inch from it. To prepare a plastic packaging film for

printing, this corona treater station is located immediately ahead of the printing machine, and a ribbon of the plastic film, which typically is 3 to 6 feet wide and is called the "web," is fed through the air gap at the speed of the printing machine, which could be as fast as 3,000 feet per minute. Electric power of 10,000 volts or more at a frequency of 10,000 Hertz or higher is delivered to the brush electrode. The resulting corona discharge from the brush electrode across the entire width of the web's surface alters its chemical structure so that it will accept and hold the ink to be applied by the printing machine.

The invention of the patent requires a cooling air flow through the corona discharge in the air gap between the brush electrode and the web. The patent discloses two ways to achieve that cooling air flow, each way being, in patent jargon, an "embodiment of the invention."

The first embodiment of the invention is illustrated in cross section in Figure 1 of the patent drawings, and has a brush electrode consisting of a pair of parallel quartz tubes filled with aluminum granules for conductors. The two tubes are spaced apart, and mounted across the long dimension of the end of a narrow rectangular air duct, the other end of which is connected through a manifold to an exhaust fan that draws ambient air past each side of the brush electrode through the corona in the air gap and through the space between the electrodes. The brush electrode is also spaced slightly from the walls of the air duct to allow the exhaust fan to draw a small part of the cooling air flow through the spaces between the air duct and the bush electrode to give the outside surfaces of the brush electrode also the benefit of the cooling air flow.

The second embodiment of the invention is illustrated in cross section in Figure 2 of the patent drawings, which shows a brush electrode consisting of a single, wide, quartz tube containing a conductor. The cooling air flow through the corona discharge in the second embodiment is produced by two air ducts along opposite sides of the brush electrode. One of the air ducts is connected to a fan to blow cooling air into the corona discharge in the air gap, and the other is connected to an exhaust fan to draw the cooling air out of the other side of the corona discharge in the air gap. In the cross

section drawing of Figure 2, cross hatching within the quartz tube of the brush electrode suggests that it has conductors along the top and bottom inside surfaces with empty space between the conductors where the cross section view is taken.

The written disclosure of the patent says nothing about the structure of the brush electrode of the second embodiment other than that it is box like with a substantially rectangular cross-section. The written disclosure of the second embodiment twice mentions that for additional cooling, part of the cooling air flow may be passed through the electrode, but the detailed description states, "The drawing does not show that . . ."

The undisputed record evidence shows that Pillar's accused products, for brush electrodes, use pairs of spaced apart ceramic tubes filled with conductors, and draw air through the space between the ceramic tubes to produce a cooling air flow through the corona similar to the first embodiment of the invention illustrated in Figure 1 of the patent in suit. There is no record evidence that Pillar ever made, used or sold a corona treater station having a single piece brush electrode with a cooling air flow generated through the corona by blowing air into one side of the air gap and exhausting the air from the other side similar to the apparatus shown in Figure 2 of the patent.

So the parties stipulated that Pillar does not infringe claims limited to the second embodiment and that Enercon charges Pillar with infringement of only claims covering the first embodiment. It is undisputed that patent Claims 1 to 5, which Enercon elected not to assert, are limited to the first embodiment, and that Claim 7, which Enercon never asserted against Pillar, is limited to the second embodiment. Enercon contends that Claim 6 is generic to and covers both embodiments, and that Pillar infringes Claim 6.

REASONS FOR GRANTING THE WRIT

I. The Decision of the Court of Appeals for the Federal Circuit Directly Conflicts with Decisions of the Court of Appeals for the Seventh Circuit and other Circuits.

The Court of Appeal's decision holds, "We conclude that this court does not have jurisdiction to hear Enercon's appeal."App.1, p.7. That conclusion is based on the Court of Appeals' ruling, "In *Woodard* we considered a case virtually identical to the case at hand. App.1,p.4. The Court of Appeals applied its *en banc* decision in *Woodard v. Sage Products, Inc.*, 818 F.2d 841, 2 USPQ2d 1649 (Fed. Cir. 1987), to Enercon's appeal, citing it throughout its opinion. App. 1, pp.1,3,4-5,6 and 7. The *Woodard v. Sage Products, Inc.* decision purports to implement this Court's decision in *Carson v. American Brands, Inc.*, 450 U.S. 79, 101 S.Ct. 993, 67 L.Ed.2d 59 (1981).

The Court of Appeals for the Seventh Circuit in its decision in *Holmes v. Fisher,* 854 F.2d 229, 231 (7th Cir. 1988) expressly rejected the Federal Circuit's *Woodard* decision, as follows:

> . . . *Woodard v. Sage Products, Inc.*, 818 F.2d 841 (Fed.Cir. 1987)(en banc) (holding that irreparable injury is an essential element of every appeal under §1292(a)(1)) . . . The ambiguity of *Carson,* coupled with the observation that there is usually no sound reason to have multiple appeals just because one count seeks an injunction, see Charles Alan Wright, Arthur R. Miller, Edward H. Cooper & Eugene Gressman, 16 **Federal Practice and Procedure** §3924 (1977 & 1978 Supp.) might support a bold move away from the established principle allowing an appeal in a case such as this.
>
> We think such a move inappropriate, however, and **to the extent Woodard has blazed the path, we do not follow.** Section 1292(a)(1) is decently plain: all interlocutory orders denying injunctions are appealable. [Emphasis added]

In *Holmes v. Fisher* the plaintiff appealed from a District Court decision dismissing his request for equitable relief, effectively denying him the right to represent a class, and leaving the request for damages pending. The Court of Appeals for the Seventh Circuit held that the decision was immediately appealable. While the

nature of the District Court order in the *Holmes* case cannot be directly equated to the District Court order in the present case, the Court of Appeals for the Seventh Circuit had already made plain that the differences between the two would not affect the jurisdiction created by 28 U.S.C. §1292(a)(1).

Tapeswitch Corporation of American v. Recora Co., Inc. 527 F.2d 1013 (7th Cir. 1976) decided an appeal that differs from Enercon's appeal mainly in the names of the parties and the patents involved. The plaintiff *Tapeswitch* had appealed from the District Court decision that dismissed its complaint suing Recora for patent infringement and praying for injunctive relief and damages. Recora had filed counterclaims alleging antitrust and misuse claims, which the District Court had severed for a separate trial. Recora moved to dismiss Tapeswitch's appeal on the ground that the decision was not final, but interlocutory because the counterclaims remained to be adjudicated. Tapeswitch agreed that the order was interlocutory, but contended that because it refused an injunction it was appealable under 28 §1292(a)(1). The per curiam decision of the Court of Appeals agreed with Tapeswitch, held the order appealable and denied Recora's motion.

The Court of Appeals for the Seventh Circuit, in *Graff v. City of Chicago,* 986 F.2d 1055(7th Cir. 1993), reaffirmed its construction of 28 U.S.C. §1292(A)(1) in the *Holmes* and *Tapeswitch* cases. Graff appealed from a District Court order that dismissed counts of his complaint challenging the constitutionality of a city ordinance regulating news stand operators and seeking injunctive relief, and retained one count charging the City with arbitrary and irrational treatment of his applications for a permit. The City challenged the Court of Appeals' jurisdiction over the appeal from a decision that was not final. Citing its decision in *Holmes v. Fisher,* the Court of Appeals held that it had jurisdiction under 28 U.S.C. §1292(a)(1).

Most if not all of the Courts of Appeals for the remaining circuits have also rejected the reasoning and decision of the Court of Appeals for the Federal Circuit in *Woodard v. Sage Products, Inc. Shee Atika v. Sealaska Corp.,* 39 F.3d 247 (9th Cir. 1994) held that it had jurisdiction under 28 U.S.C. §1292(1)(a) over an appeal from an interlocutory decision that denied a summary judgment motion

seeking injunctive relief, and in footnote 2 on p. 249 enlarged its explanation as follows:

> 2. This conclusion is consistent with that reached by the overwhelming majority of courts of appeal that have considered the issue. *See Feinstein v. Space Ventures, Inc.* 989 F.2d 49 n.1 (1st Cir 1993); *United States V. Bayshore Associates, Inc.*, 934 F.2d 1391, 1395-96 (6th Cir. 1991); *Atwood Turnkey Drilling, Inc. v. Petroleo Brasileiro, S.A.*, 875 F.2d 1174, 1176 (5th Cir. 1989), cert. denied, 493 U.S. 1075, 110 S.Ct. 1124, 107 L.Ed.2d 1030 (1990); *Tri-State Generation & Transmission Ass'n Inc. v. Shoshone River Power, Inc.*, 874 F.2d 1346,1351 (10thCir. 1989); *Cohen v. Board of Trustees of the Univ. of Medicine & Dentistry,* 867 F.2d 1455, 1464-67 (3rd Cir. 1989); *Holmes v. Fisher,* 854 F.2d 229, 231 (7th Cir.1988); *I.A.M. Nat'l Pension Fund Benefit Plan A v. Cooper Indus., Inc.* 789 F.2d 21,24 n.3 (D.C.Cir.) cert. denied 479 U.S. 971, 107 S.Ct.473, 93 L.Ed.2d 417 (1986); *Cable Holdings of Battlefield, Inc. v. Cooke,* 764 F.2d 1466.1471 (llth Cir. 1985). But see *Woodard v. Sage Prods.,Inc.*, 818 F.2d 841, 853 (Fed.Cir.1987)(en banc).

The above cited decisions manifest increasing disintegration of uniformity in the Courts of Appeals' applications of 28 §1292(a)(1) and a predictably growing volume of litigation over that issue, all of which results from perceived ambiguity in this Court's decision in *Carson v. American Brands Inc.*, 450 U.S. 79, 101 S.Ct. 993, 67 L.Ed.2d 59(1981). To restore conformity among the courts of appeals and prevent further litigation, and for the reasons set forth below, this Court should grant this petition for certiorari.

II. The Decision of Court of Appeals for the Federal Circuit Conflicts with 28 U.S.C. §1292(a)(1) and This Court's Precedents, and Erroneously Dismissed the Appeal in This Case.

Based on its finding that Enercon's appeal is "virtually identical" to Woodard's in *Woodard v. Sage Products Inc.*, 818 F.2d 841, 2 USPQ2D 1649 (Fed. Cir. 1987) which purports to implement this Court's decision in *Carson v. American Brands, Inc.*, 450 U.S. 79, 101 S.Ct. 993, 67 L.Ed.2d 59 (1981), the Court of Appeals held:

> Enercon's case in the district court, therefore, is not final, which is clearly evidenced by the district court's action in vacating the erroneously entered judgment. Further, the district court's order, while injunctive in nature, has not been shown from the record to result in serious, perhaps irreparable, harm or to be effectively unreviewable following decision on the remaining issues.

App.1, p.7

But in *Carson v. American Brands, Inc.*, the District Court had denied a joint motion of the parties to enter a consent decree implementing their negotiated settlement of the action, thus advancing the case to trial. The Court of Appeals dismissed the appeal for lack of jurisdiction under, *inter alia,* 28 §1292(a)(1) because the District Court's order did not refuse an injunction. But the parties' consent decree included an injunction, and this Court noted that, "Although the District Court's order declining to enter the proposed consent decree did not in terms 'refus[e]' and 'injunctio[n],' it nonetheless had the practical effect of doing so." 450 U.S. 83. This Court added that in such cases ". . . a litigant must show more than that the order has the practical effect of refusing an injunction" 450 U.S. at 84, to measure whether the order fell within the class of interlocutory orders that Congress intended to be appealable for refusing injunctions. This Court concluded, "We hold that the order is appealable under 28 U.S.C. §1292(a)(1), and accordingly reverse the Court of Appeals." *Id.*

This Court adopted the definition of the "more" that such a litigant must show from its earlier decision in *Baltimore Contractors, Inc. v. Jacob H. Bodinger,* 348 U.S. 176, 181, 75 S.Ct. 249, 252 (1954) where it describes Congress' intent in enacting the various categories of appealable interlocutory orders, as fulfilling a "need to permit litigants to effectually challenge interlocutory orders of serious, perhaps irreparable consequence."

The Court of Appeals for the Federal Circuit in *Woodard v. Sage Products, Inc.* severed this Court's rationale in the *Carson* case from the interlocutory order there in issue, and extracted from that rationale its rule that for appeals to the Federal Circuit Court of Appeals there is ". . . a general requirement for separate showings of harm and unreviewability which had to be satisfied to establish appealability of all deemed injunctive orders." 818 F.2d at 851.

Congress, by statute, explicitly voiced its intent that patent rights be enforced by injunctions and that patentees be entitled to immediate appeal from interlocutory orders that refuse injunctions to enforce patent rights. Congress declared that "A patentee shall have a remedy . . . for infringement of his patent" 35 U.S.C. 281, and in 35 U.S.C. 283 that "The several courts having jurisdiction . . . may grant injunctions . . . to prevent the violation of any right secured by patent . . ." . Then in 28 U.S.C. §1292(c) Congress granted "The United States Court of Appeals for the Federal Circuit . . . exclusive jurisdiction (1) of an appeal from an interlocutory order or decree described in subsection (a) . . . of this section . . .," which provides that ". . . the courts of appeals shall have jurisdiction of appeals from (1) "Interlocutory orders of the district courts of the United States . . . refusing . . . injunctions . . . " 28 U.S.C. §1292(1)(a).

Nevertheless, the Court of Appeals decreed that the order Enercon appeals from is in a new, conditionally appealable category which it created in the *Woodard* case. The nature of the enterprise engaging the Court of Appeals in this matter is revealed by its imposition as conditions for jurisdiction over the new category that appellant prove the District Court's "order causes serious, if not irreparable, consequences and can be effectually challenged only by immediate appeal, 818 F.2d at 842, 2 USPQ2d at 1649." App. 1,

p. 5., which it copied from this Court's decision in *Carson v. American Brands, Inc.*, 450 U.S. 79, 81, where this Court imported it from *Baltimore Contractors* to apply it to orders which have "the practical effect of refusing injunctions," but strain the boundaries of the plain meaning of the statutory language "Interlocutory orders . . . refusing injunctions," to determine on which side of the boundary the order falls. This reference to legislative intent to construe the limits of statutory language is very different from the exercise of the Court of Appeals for the Federal Circuit in this case.

The Court of Appeals used that verbal formula, just as Congress did, to define a new category of conditionally appealable interlocutory orders. The category is so new that the Court of Appeals has not yet settled on a name for it, sometimes calling it "deemed injunctive orders," sometimes "orders injunctive in nature" and sometimes "order having the effect of denying an injunction." Since no appellant has yet proved those conditions to the satisfaction of the Court of Appeals for the Federal Circuit, arguably the Court of Appeals has not extended its jurisdiction, but reduced it by eliminating appeals from orders refusing injunctions.

But whether extending or reducing its jurisdiction, the Federal Circuit has engaged in the very conduct that this Court prohibited in its decision in *Baltimore Contractors, Inc. v. Jacob H. Bodinger* as follows:

> This Court, however, is not authorized to approve or declare judicial modification. It is the responsibility of all courts to see that no unauthorized extension or reduction of jurisdiction, direct or indirect, occurs in the federal system. Shanferoke Coal & Supply Corp. of Delaware v. Westchester Service Corp., 293 U.S. 449, 451, 55 S.Ct. 313, 79 L.Ed.583.

348 U.S. 181, 75 S.Ct. 252.

The decision of the Court of Appeals for the Federal Circuit violates the letter and intent of 28 U.S.C. 1292(a)(1), distorts this Court's decision in *Carson v. American Brands, Inc.*, ignores this Court's precedent in *Baltimore Contractors, Inc. v. Jacob H.*

Bodinger, and should be reversed.

III. The Decision of the District Court Conflicts with Precedents of This Court That Created The United States Patent System and Have Governed Its Enforcement for more that a Century.

As the foregoing section shows, this Court's precedents carry very little weight in the Court of Appeals for the Federal Circuit in matters dealing with its jurisdiction in patent cases. But this Court's precedents carry no weight at all in the United States District Court for the Eastern District of Wisconsin in patent cases.

The Claim of a United States patent is the United States Patent. The rest of the specification and drawings perform important auxiliary functions, but the Claim is the patent. It gives the inventor an exclusive right for a limited time to everything the Claim covers. That was not always so.

For example, in *Winans v. Denmead,* 15 How. 330, 14 L.Ed. 717 (1854), this Court charged the courts with the responsibility of determining the scope of the exclusive patent right from the entire specification and record evidence, 15 How. at 338, and admonished the courts that the scope was not to be restricted by the patentee's statement of what he particularly claimed as his invention. 15 How. at 341-342. Over the years, practice under that regime refined the principles of patent law and earned constantly increasing respect for and reliance on the claims issued by the Patent Office, as this Court recognized 22 years later in *Merrill v. Yoemans,* 94 U.S. 568, 574, 24 L.Ed. 235 (1876), and for the first time distinguished the "claim" separately from the "description," 94 U.S. 569, and held that "This distinct and formal claim is, therefore, of primary importance, in the effort to ascertain precisely what it is that is patented . . ." 94 U.S. 570.

A year later, this Court tacitly reversed its instructions given in *Winans v. Denmead* by declaring that the courts would no longer perform any of the functions that Winans had described, that those functions had been "cast upon the Patent Office" and that patentees would be bound by their claims. *Keystone Bridge Company v. Phoenix Iron Company,* 95 U.S. 274, 278-279, 24 L.Ed. 344

(1877). This Court took the final step in *Railroad Co. v. Mellon,* 104 U.S. 112, 118, 26 L.Ed. 639(1881), where, citing its earlier decision and the status of practice in the courts and the Patent Office, held "that the scope of letters patent should be limited to the invention covered by the claim . . . and cannot be enlarged by the language used in the other parts of the specification."

However, old doctrines are not quickly laid to rest, and five years after *Railroad Co. v. Mellon,* this Court was still facing arguments rooted in the age of *Winans v. Denmead* when it issued its most famous, albeit exasperated statement of the law in *White v. Dunbar,* 116 U.S. 47, 7 S.Ct. 72, 75 (1886)

> Some persons seem to suppose that a claim in a patent is like a nose of wax, which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it, and making it different from what it is. The claim is a salutary requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject further. *See Keystone Bridge Co. v. Phoenix Iron Co., 95 U.S. 274, 278; James v. Campbell, 104 U.S. 356, 370.*

During the following century and more, those seminal, decisions of this Court governed and defined the U.S. patent system — until the District Court's decision in this case, which set the calendar back to the days of *Winans v. Denmead.*

This case differs from all of those decided by this Court in its seminal decisions cited above in two respects. First, in those cases, this Court was responding to attempts by patentees to enlarge the scopes of their patents' protection beyond the plain meaning of their claims, and often contrary to the descriptions of their patents. Here Enercon seeks only the scope of the plain meaning of Claim 6 according to standard dictionary definitions of its words, and there is no dispute that the specification of the patent discloses exactly what Enercon contends for the plain meaning of Claim 6.

Second, in the seminal decisions cited above, this Court, to protect the public's need to be able to rely on the plain language of the claims, rejected all departures from the claim language, and in those cases the proffered departures would have expanded the scopes of those claims beyond the plain meaning of the claim language. Here the District Court's construction departs radically from the language of Claim 6, and does so by adding words that are not present either in Claim 6 or anywhere else in the patent, to contract the scope to less than the plain meaning of the language so as to exclude the first embodiment of the invention disclosed in the patent from Claim 6.

Specifically, the District Court changed the last element of Claim 6, "in which part of the cooling air flow is passed through said brush electrode," to — in which part of the cooling air flow is passed longitudinally through the hollow interior of a single part brush electrode —. Nothing in the patent supports that departure from the dictionary meanings of the words in Claim 6, and the patent expressly denies disclosing how the air flow is passed through the large, single piece electrode of the second embodiment, and does not disclose whether it is hollow throughout its length.

The District Court's Decision and Order does not reveal the objectives that motivated the Court to treat Claim 6 as if it were "a nose of wax." So it is legitimate to note the objectives it serves. Limiting Claim 6 to the second embodiment avoided the factual issues inherent in applying the claim language to Pillar's products. Also, deciding the case on noninfringement avoided addressing the major, vigorously contested issues of the case, namely: patent validity and enforceability. Deciding those defenses would have

required resolving issues of burdens of proof, standards of proof, and ruling on the many objections to large amount of evidence on which the Court postponed rulings until its findings and conclusions.

The District Court required seven years to find five days that it could devote to the trial of the patent liability portion of this case. The District Court required two years to construe Claim 6. The patent expires on May 1, 2001. Two antitrust and three unfair competition counterclaims remain to be tried before a final judgment can be entered in this case, and appellate review obtained. That the patent will expire before the District Court's construction of Claim 6 can be corrected to comply with this Court's decisions cited above, is predictable with the certainty of death and taxes.

This case is akin to the fictional case of *Jarndice v. Jarndice* that provides the framework for Charles Dickens' great novel, *Bleak House. Jarndice v. Jarndice* was a will contest that lasted several generations, and just before the validity of the will was to be decided the case was dismissed, accompanied by gales of laughter of Chancery's staff and bar, because the entire estate had been consumed by the cost of the Chancery proceedings. In this case, the *res* of the property, being an idea, is indestructible, but its duration is as sharply limited as the value of the estate in *Jarndice v. Jarndice.* So the property in this case, like that in *Jarndice v. Jarndice,* will be consumed by judicial proceedings and delays before its validity can be determined and the beneficiary of that determination can enjoy it, unless this Court grants this petition for a writ of certiorari to review and correct the erroneous decisions below.

III. The Questions Presented Are Important.

Under the perceived ambiguity of this Court's decision in *Carson v. American Brands, Inc.,* uniformity of jurisdictions in the courts of appeals over interlocutory orders refusing injunctions has crumbled, and the radical departure from the statutory language in the decisions of the Court of Appeals for the Federal Circuit in *Woodard v. Sage products, Inc.* and now this case threatens to reduce definition of such jurisdiction to an irreconcilable collection of fact findings. As this Court stated in *Baltimore Contractors, Inc.*

v. Jacob H. Bodinger, 348 U.S. 182, 75 S.Ct. 253, "Any such ad hoc decisions disorganize practice by encouraging attempts to secure or oppose appeals with the consequent waste of time and money." The Court in *Holmes v. Fisher,* 854 F.2d 229, 231 (7th Cir. 1988) described the problem created by the *Woodard* decision in more concrete terms,

> The process of characterization cannot be allowed to feed back into the propriety of an appeal from an order that is unquestionably an injunction. To do so would not only alter the operation of the statute but also allow the methods used to resolve borderline cases to dominate the center of the spectrum, driving out all vestiges of certainty. We emphasized just the other day the importance of having clear rules of appellate jurisdiction . . . A litigant is entitled to know just when it is entitled (or required, see *Botanic v. Becton Dickinson & Co.,* __ U.S. __, 108 S.Ct. 1717, 100 L.Ed.2d 178 (1988)) to take an appeal, and an appellate court should be able to accept or reject the appeal without squandering on jurisdictional matters time needed to decide the case on the merits.

Those predictions have been validated in Enercon's appeal from the District Court's order that unquestionably refused injunctions. The Court of Appeals for the Federal Circuit, by adding a requirement of showings of irreparable injury where Congress has already found injunctive relief appropriate, has slammed shut its doors against precisely the sort of questions of law that are its very *raison d'etre.*

The District Court's Decision and Order, as this Court stated in *White v. Dunbar,* 7 S.Ct. 76, " is unjust, as well as an evasion of the law, . . .[in construing Claim 6] . . .in a manner different from the plain import of its terms." Over a century ago, this Court established the law that has prevailed uniformly every since. It is timely now, before decisions inspired by that of the District Court here, tear apart that uniformity, replace the Patent Office with the federal judiciary and deprive U.S. patents of reliability, to reaffirm those

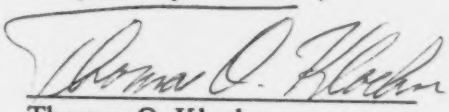
principles that have served inventors, the public and this nation so well and so long.

This Court's review is needed to preserve Congress' determination of appellate jurisdiction and the United States patent from degradation by the decisions of the lower courts in this case.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,



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APPENDIX 1

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1132

ENERCON INDUSTRIES CORPORATION,
and AHLBRANDT SYSTEMS, INC.,
Plaintiffs-Appellants,

v.

PILLAR CORPORATION, PILLAR TECHNOLOGIES, INC.,
and PILLAR TECHNOLOGIES, L.P.,
Defendants-Appellees.

DECIDED: January 31,1997

Before ARCHER, Chief Judge, SMITH, Senior Circuit Judge, and MICHEL, Circuit Judge.

ARCHER, Chief Judge.

DECISION

Enercon Industries Corp. and Ahlbrandt Systems, Inc. (collectively Enercon) appeal the "Decision and Order" (order) of the United States District Court for the Eastern District of Wisconsin dismissing their claim for infringement of U.S. Patent No. 4,446,110 (the '110 patent) against Pillar Corp., Pillar Technologies, Inc., and Pillar Technologies, L.P. (collectively Pillar), Enercon Indus. v. Pillar Corp., No. 86-C-740 (E.D. Wis. June 14, 1995). Outstanding counterclaims remain pending before the district court. We dismiss for lack of jurisdiction because this appeal does not satisfy the provisions of Rule 54(b), Fed. R. Civ. P., or 28 U.S.C. § 1292 (1994).

BACKGROUND

Enercon filed suit against Pillar on July 18, 1986, for infringement of the '110 patent relating to means for cooling the active

discharge side of a brush electrode.[1] Pillar filed antitrust, unfair competition and other counterclaims. These counterclaims were stayed pending resolution of the infringement claim.

Following trial on the infringement claim, in a decision dated June 14, 1995, the district court held that the '110 patent was not infringed by Pillar and ordered Enercon's amended complaint dismissed with prejudice. The court made no mention of the outstanding counterclaims. Believing the entire action should be dismissed, the clerk of the court entered judgment dismissing the case on June 14, 1995. On January 23, 1996, costs were taxed against Enercon. Meanwhile, Enercon had instituted this appeal on December 14, 1995.

While this appeal was pending, Enercon sought review by the district court of the assessed costs. At this time, the court considered its earlier decision and the judgment dismissing the case in its entirety. The court determined that the judgment had been entered in error and vacated the judgment. The court stated, "[a]pparently under the assumption that the case was dismissed in its entirety, on January 23, 1996, Chief Deputy Clerk . . . taxed costs against Enercon. To date, the Court has entered no order dismissing this action in its entirety or ordering costs; therefore, the judgment of June 14, 1995, is vacated. As a result, the clerk's January 23, 1996, order granting costs is inappropriate at this time and must also be vacated." Enercon Indus. v. Pillar Corp., No. 86-C-740 (E.D. Wis. May 6, 1996).

DISCUSSION

This court must, as a threshold matter, ascertain whether it has jurisdiction over Enercon's December 14, 1995, appeal from the district court's order and vacated judgment.[2] Generally, appeal

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[1] Enercon amended its complaint on December 13, 1988.

[2] In determining whether we have jurisdiction, we apply our own law and not the law of the regional circuit. Woodard v. Sage Prods., Inc., 818 F.2d 841, 844, 2 USPQ2d 1649,1651 (Fed. Cir. 1987) (in banc).

may only be taken from a final decision[3] disposing of an entire case. See, e.g., Coopers & Lybrand v. Livesay, 437 U.S. 463, 467 (1978) ("Federal appellate jurisdiction generally depends on the existence of a decision by the District Court that 'ends the litigation on the merits and leaves nothing for the court to do but execute the judgment." (quoting Catlin v. United States, 324 U.S. 229, 233 (1945))).

In limited circumstances, however, appeal may be taken from an order deciding less than the entire case. Rule 54(b) of the Federal Rules of Civil Procedure allows "a district court to sever an individual claim that has been finally resolved," W.L. Gore & Assocs., Inc. v. International Med. Prosthetics Research Assocs., Inc., 975 F.2d 858, 861, 24 USPQ2d 1195, 1198 (Fed. Cir. 1992), only after the district court expressly determines that there is no reason for delay and expressly directs the entry of judgment, see Spravtex, Inc. v. DJS&T, 96 F.3d 1377, 1379, 40 USPQ2d 1145, 1146 (Fed. Cir. 1996). In addition, an appellate court has discretion to hear interlocutory orders certified by the district court as involving a controlling question of law. 28 U.S.C. §1292(b). Enercon did not seek to appeal under either of these procedures and, as a result, the district court did not make findings under Rule 54(b) and did not certify its order for interlocutory appeal under § 1292(b).

Enercon asserts, however, that we have jurisdiction in this case under 28 U.S.C. § 1292(a),(c). These sections provide:

> (a) Except as provided in subsections (c) and (d) of this section, the courts of appeals shall have jurisdiction from:
>
> (1) Interlocutory orders of the district court . . granting, continuing modifying, refusing or dissolving injunctions . . .
>
> * * *

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[3] This appeal was filed based on 28 U.S.C. §1295(a) (1994), which confers jurisdiction to this court in an appeal from "a final decision of a district court" in a case based in whole or in part on the patent statute.

(c) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction —

(1) of an appeal from an interlocutory order or decree described in subsection (a) or (b) of this section in any case over which the court would have jurisdiction of an appeal under section 1295 of this title ....

28 U.S.C. § 1292.

I.

Enercon argues that the district court's dismissal of its claim for patent infringement effectively disposed of its request in the amended complaint for an injunction attendant to a finding of infringement and that the order is, therefore, a denial of a permanent injunction. Enercon cites our in banc decision in Woodard v. Sage Products, Inc., 818 F.2d 841, 2 USPQ2d 1649 (Fed. Cir. 1987), and argues that it would be irreparably injured if it were not allowed to appeal at this time.

In Woodard we considered a case virtually identical to the case at hand. The district court had granted summary judgment of non-infringement in favor of one of several defendants. This was not a final judgment, and the court did not certify the order for interlocutory appeal or enter a separate final judgment under Rule 54(b). On appeal, the question was raised as to whether the order could be appealed as a denial of a permanent injunction under 28 U.S.C. § 1292(a)(1), (c)(1). This court held that it could review such an interlocutory order only if the order is injunctive in nature, 818 F.2d at 850, 2 USPQ2d at 1655, and "such order causes serious, if not irreparable, consequences and can be effectually challenged only by immediate appeal," 818 F.2d at 842, 2 USPQ2d at 1649. Moreover, the court stated that the "irreparable harm and lack of effective review must be apparent from the record." 818 F.2d at 854, 2 USPQ2d at 1658-59. The court then dismissed the appeal for lack of jurisdiction, noting that Woodard had not sought a preliminary injunction and had not made a sufficient showing on the record that denial of an injunction pendente lite would result in irreparable harm or that the denial would be effectively unreviewable after trial. 818 F.2d at 854, 2 USPQ2d at 1659.

The holding in Woodard, that an interlocutory order can be appealed under § 1292(a), (c), requires that the order have the effect of denying a permanent injunction and that the order have (per Carson v. American Brands, Inc., 450 U.S. 79, 84 (1981)) serious, perhaps irreparable, consequences and be effectively unreviewable at a later time.

To show the required irreparable harm and unreviewability, Enercon primarily argues that the history of this case, as revealed in the docket sheets, indicates that there is no likelihood of entry of final judgment before the '110 patent expires on May 1, 2001. As a result, it says it will have lost all of its right to exclude under the issued patent. Enercon asserts that this loss of patent protection will severely affect its competitive and market positions and that, as a result, it will be irreparably injured by the order effectively denying its request for a permanent injunction. In support, Enercon states that its market share increased from 7% in 1980, the year before it introduced the patented device, to 45% of the U.S. market in 1985 while during that same time Pillar's share decreased from 54% to 26%.

These data relate to Enercon's market position eleven years ago. Apparently, Enercon seeks to have this court draw the negative inference that many years later its market share will decline as a result of the court's noninfringement ruling. As stated in Woodard, 818 F.2d at 854, this type of factual argument (that the infringer will capture market share) is not one that this court can or will resolve in the first instance. Moreover, such dated and unpersuasive evidence cannot satisfy the requirements to establish serious, probably irreparable harm and to show an immediate need for appellate review, see Carson, 450 U.S. at 84.

Although Enercon asked for a preliminary, as well as a permanent, injunction in its amended complaint, it apparently has not pursued a preliminary injunction. We have not been directed to anything in the record that indicates that Enercon ever filed a motion for preliminary injunction or otherwise requested the court to consider granting a preliminary injunction. As in Woodard, Enercon's failure to affirmatively seek preliminary injunctive relief virtually precludes a conclusion that it will be irreparably

harmed by the denial of an injunction pendente lite. Woodard, 888 F.2d at 854.

II.

Enercon seems to argue that the district court's finding of non-infringement also effectively denied preliminary injunctive relief as sought in its amended complaint. That argument also fails. As we have said, in order for "this court to have jurisdiction over an appeal from an order denying a preliminary injunction, the district court's order must have been entered in response to a request by the appealing party." Lermer Germany GmgH v. Lermer Corp., 94 F.3d 1575, 1577, 39 USPQ2d 2014, 2015 (Fed. Cir. 1996). As noted above, Enercon never pursued a preliminary injunction beyond its request in its complaint, and the court's order was thus not entered in response to a specific request for a preliminary injunction.

III.

Finally, Enercon's assertion that the patent will have expired by the time the case reaches final judgment in the district court is based on pure speculation and conjecture. Enercon contends, based on the length of time between the filing of the suit and the decision on the infringement claim, that it could be years before the court renders a final decision in the case and that by that time the patent will have expired. This conjecture does not prove that the remaining stage of the proceeding will be delayed, nor would delay by itself establish irreparable injury and non-reviewability. See Woodard, 818 F.2d at 853-854 (rejecting patentee's argument that the remaining term of the patent was short, only three years, and that patent would expire if not granted an immediate right of appeal).

Enercon has pointed to no significant distinction between Woodard and this case. The fact that Woodard involved an order resolving a claim as to one of several defendants, as compared to the district court's order resolving one of several claims, is not a meaningful distinction. In both cases outstanding claims must still be adjudicated. See Norco Prods., Inc. v. Mecca Dev., Inc., 821 F.2d 644, 645, 3 USPQ2d 1319, 1320 (Fed. Cir. 1996) (applying

Woodard to the dismissal of one of many claims); cf. Spraytex, 96 F.3d at 1381, 40 USPQ2d at 1149 (Fed. Cir. 1996) (holding that in the absence of Rule 54(b) certification, no appeal may be taken from a judgment disposing of fewer than all actions consolidated by the district court). Enercon's case in the district court, therefore, is not final, which is clearly evidenced by the district court's action in vacating the erroneously entered judgment. Further, the district court's order, while injunctive in nature, has not been shown from the record to result in serious, perhaps irreparable, harm or to be effectively unreviewable following decision on the remaining issues.

We conclude that this court does not have jurisdiction to hear Enercon's appeal.

DISMISSED

APPENDIX 2

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF WISCONSIN

ENERCON INDUSTRIES CORPORATION,
and AhlbrandtT SYSTEMS, INC.,

Plaintiffs,

-vs- Case No. 86-C-740

PILLAR CORPORATION, PILLAR
TECHNOLOGIES, INC., and PILLAR
TECHNOLOGIES L.P.,

Defendants.

DECISION AND ORDER

This is a patent infringement suit which, by stipulation, was tried to the Court on the liability issues only. The plaintiffs, Enercon Industries Corporation and Ahlbrandtt Systems, Inc. (hereinafter "Ahlbrandt/Enercon"), assert that the defendants, Pillar Corporation, Pillar Technologies, Inc., and Pillar Technologies L.P. (hereinafter "Pillar"), infringe Claim 6 of U.S. Patent No. 4,446,110 (" the '110 patent").1 The '110 patent contains two embodiments represented in drawings found in Fig. 1 and Fig 2. which are attached to this opinion as Exhibits 1 and 2.

Pillar asserts that Claim 6 is not infringed because Claim 6 covers only fig. 2 of the '110 patent and Pillar does not practice that embodiment. Ahlbrandtt Enercon concede that Pillar has not practiced the second embodiment of the invention shown in Fig. 2, but assert that Claim Six reads on the first embodiment, which Pillar does allegedly practice. Pillar responds that if Claim 6 of the '110 patent covers Fig. 1, it is invalid for a variety of reasons

[1]Enercon/Ahlbrandt charged infringement of Claims 1 through 5 and 7 of the '110 patent and of U.S. Patent No. 4,774,061, but these were dismissed pursuant to stipulation of the parties.

found under 35 U.S.C. § 102(b) and elsewhere. The Court finds that the disputed and critical language of Claim 6 does not read on Fig. 1, but only on Fig. 2. of the '110 patent. Because the Court so finds, it does not address the invalidity defenses.

FACTUAL FINDINGS[2]

A. The Patent

The '110 patent was issued on May 1, 1984, on the Application of Andreas Ahlbrandtt. It was originally filed in the Federal Republic of Germany on October 23, 1980, and the corresponding U.S. Application was filed in the U.S. Patent and Trademark Office on February 25, 1981.

B. The Parties

When the patent issued, it was owned by the inventor, Andreas Ahlbrandtt, and plaintiff Enercon held an exclusive license with the right to enforce the patent. In 1985, Ahlbrandt Systems, Inc. was formed and the '110 patent was assigned to it subject to Enercon's license.

Originally Pillar Corporation had its principal place of business in Milwaukee, and in 1985 it conveyed the business to its subsidiary, Pillar Technologies, Inc. In 1991, Pillar Technologies conveyed the business to a limited partnership, Pillar Technologies L.P.

C. The Technology

The technology involved is known as corona treating and involves the use of corona treaters. Corona treaters "treat" the surfaces of plastic films or metal foils so ink or other material can be applied to the film or foil surface. To achieve this objective it is necessary to equalize the surface tensions of the film and the ink,

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[2] The Court will lay out its factual findings in the manner of the post-trial memoranda submitted by the parties. The findings are not meant to be exhaustive. All of the findings are supported by the Court's review of the entire record. The specific findings, however, provide a general explanation for the Court's conclusions herein.

or adhesive, so that the ink will stick to the surface of the film. Corona treating achieves this objective. This process extends to countless commercial and industrial applications.

Untreated surfaces of film simply do not accept ink and adhesives well. It was recognized early on that films could be treated to better take ink and adhesives by exposing the surfaces of the film to a gas flame. An early way of doing this was to pass the plastic film through the flames of a line of gas burners. In addition, chemical treating of the surfaces was also done. Later it was learned that the same effect could be accomplished without chemicals and without the danger of open flames by using a corona treater device.

A corona treater system consists of two components. One is a power supply, sometimes called a generator, that converts commercial power to high frequency electric power and that combines with a high voltage transformer to raise the voltage of the high frequency electrical power. The other component is the treater station which is the structure including two electrodes that is connected across the output to the power supply that creates an air gap across which a corona discharge occurs. This discharge creates a corona resulting from high voltage electricity being passed between two electrodes with different electric potentials. One electrode (or group of electrodes) is at a high voltage potential, and the other electrode is connected to ground. There must be an insulator, or dielectric covering, on one of the two electrodes in order to generate the corona discharge.[3] The corona discharge found in this air gap is caused by the ionization of the gas between the electrodes, and occurs when the potential exceeds a certain value but is not sufficient to cause sparking between the electrodes. While "difficult to define," it is an "intermediate con-

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[3] The resulting discharge emits a crackling sound and ultraviolet light producing a purple glow. The corona discharge is generated in this air gap. In this gap a "corona wind" is created.

dition" between a brush discharge and a spark discharge. (Trial Tr. p. 175.)[4]

The above-mentioned dielectric, which is a material that does not conduct electricity, is inserted between the high voltage electrode and the grounded roll to prevent the corona from breaking down into an arc. An arc must be avoided because it takes all of the electrical energy from the corona causing treatment to cease, and the energy concentrated in the arc destroys the web.[5] Previous attempts to place the dielectric on a stationary high voltage electrode failed because prolonged exposure to the heat of the corona discharge, coupled with the highly corrosive atmosphere and the high voltage high frequency field, quickly broke down the dielectric, causing pin holes to form in it and expose the stationary electrode. Before the invention of the patent in issue, the dielectric had to be coated onto the grounded roll because it rotated and the rotation only exposed the dielectric to the corona for an instant before rotating the portion exposed out of the electric field and the corrosive atmosphere.[6]

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[4] "Corona discharges typically take place into free space like St. Elmo's fire was a corona discharge where air becomes the current-limiting mechanism . . . ." (Tr. of Louis Rosenthal p. 175, ll. 15-18.)

[5] The high voltage electrodes of corona treaters create two undesirable by-products — heat and ozone. Excessive heat damages components of the treater, especially the dielectric coverings. Heat can also cause distortion of the high voltage electrode, which results in and uneven air gap and uneven treatment across the web of plastic film. Ozone gas is undesirable because it can be both harmful and corrosive. Both heat and ozone can be eliminated by blowing or sucking air through a duct connected to a housing covering the high voltage electrode or electrodes. The airflow draws away the ozone and serves to cool the energized electrode or electrodes in the housing.

[6] Prior to the invention of the '110 patent, a corona treater station was developed for treating metal foils that used a bare grounded roll and dielectric covered high voltage electrodes. The high voltage electrode in these metal foil corona treaters took the form of a roll that was rapidly rotated to move the dielectric covering out of the corona before it broke down. It is mentioned by Ahlbrandt in the '110 patent.

Since the invention of the patent in issue, however, the dielectric covering can now be placed on either the high voltage electrode or the ground electrode. When the dielectric covering is on the ground roll, the high voltage electrode is bare metal. This system is typically referred to as a "covered roll" treater. When the dielectric covering is on the high voltage electrode, the ground roll is bare metal. This latter system is typically referred to as a "bare roll" treater.

The dielectric sleeve covering the grounded roll in a prior corona treater station had a limited and completely unpredictable life because it could pin hole in a matter of months or a matter of hours. The dielectric sleeves are very expensive to replace, and replacing a grounded roll with a failed dielectric sleeve causes substantial loss of production because of the extensive down time of high cost production machinery.

D. '110 Patent

The '110 patent is an improvement in corona treaters because it can be operated with relatively high efficiency without electrical breakdown occurring. The problems created by excessive heat and ozone are minimized. This is accomplished in two ways, according to the embodiments. "The primary object of the invention is to provide means for cooling the active discharging side of a brush electrode." ("Summary of the Invention," col. 1, II. 35-37, '110 Patent.)

The first way or embodiment is illustrated in Fig. 1 of the '110 patent and claimed in Claim 1, which recites as follows:[7]

> Apparatus for treating the surface of materials by electric brush discharge, said apparatus comprising:
>
> a. a first electrode for guiding articles to be treated and

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[7] The following letter delineations represent col. 5, II. 51-63, and col 6, II. 1-8, of the '110 patent. This is the manner in which the patent language was referenced at trial and the court uses it here.

b. at least one facing brush electrode having a coating, which can be connected to opposite potential and
c. is arranged to be cooled by a cooling air flow flowing over the outside thereof,

d. wherein guide means are provided for guiding the cooling air flow at least partly through the corona along the active discharging side of said brush electrode, and

e. in which the brush electrode is a double electrode formed from two juxtaposed single electrodes and

f. in which an air exhausting pipe is provided,

g. said single electrodes forming part of a wall of said air exhausting pipe and

h. air inlets being formed between the said brush electrodes and between said electrodes and the sides of said air exhausting pipe
i. the cross-section of the air inlet between said brush electrodes being larger than the cross-sections of the air inlets located between the brush electrodes and the longitudinal sides of said air exhausting pipe.

The second embodiment is shown in Fig. 2 and described at column 5, lines 1-45. In this machine, the energized electrode is a single hollow electrode.[8] The electrode is cooled primarily by compressed air which is forced along the outside of the electrode, through the corona, and is exhausted on the other side of the electrode. The second embodiment also envisions a further cooling improvement. For further cooling, air or some other medium can be passed through the center of the hollow electrode. (Ex. 501, fig. 2; col. 2, I. 63 - col. 3, I. 33; col. 5, II. 1-45.)

This "further cooling" embodiment is claimed in Claim 6 of the Ahlbrandtt '110 patent, which recites as follows:

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[8] This finding of act is discussed *infra*.

Apparatus for treating the surface of materials by electric brush discharge, said apparatus comprising:

a. a first electrode for guiding materials to be treated and

b. at least one facing brush electrode having a coating, which can be connected to opposite potential and

c. is arranged to be cooled by a cooling air flow flowing over the outside thereof,

d. wherein guide means are provided for guiding the cooling air flow at least partly through the corona along the active discharging side of said brush electrode,

e. in which said brush electrode has a discharging surface facing said first electrode, and

f. the first electrode guiding the material to be treated has a surface which guides the material and faces said brush electrode, and

g. in which part of the cooling air flow is passed through said brush electrode.
(emphasis added).

Other findings of fact will be referenced in the Court's Conclusions of Law.

CONCLUSIONS OF LAW

A. Standards of Law.

In deciding whether Pillar has infringed Claim 6[9] of the '110 patent, the Court is guided by the following standards.

First, Enercon has the burden of proving infringement, by a preponderance of the evidence. ZMI Corp. v. Cardiac Resuscitator Corp., 844 F.2d 1576, 1582 (Fed. Cir. 1988); SRI Int'l v.

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[9] As discussed in the Findings of Fact, Ahlbrandt/Enercon originally charged Pillar with also infringing Claim 1-5 and 7 of the '110 patent and U.S. Patent No. 4,774,061, but dropped the claims shortly before trial.

Matsushita Elec. Corp., 775 F.2d 1107, 1123 (Fed. Cir. 1985); Hughes Aircraft Co. v. United States, 717 F.2d 1351, 1361 (Fed. Cir. 1983).

Second, analysis of patent infringement involves the legal determination of the scope of the claim, and whether on the facts the accused structure is covered by the properly constructed claim. Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 908 (Fed. Cir. 1988).

Third, if an allegedly infringing product falls literally within the scope of properly interpreted claims, literal infringement is made out, and that is the end of the inquiry. Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605, 607 (1950).

Fourth, an accused device literally infringes a properly constructed claim if each and every element of the claim is found in the accused device. Texas Instruments, Inc. v. United States International Trade Com, 805 F.2d 1558,1562 (Fed. Cir. 1986); Lemelson v. United States, 752 F.2d 1538, 1551 (Fed. Cir.1 985).

Fifth, while patent claim language may be clear, it is not dispositive and reference is made to the patent specification and its prosecution history to properly construe the words used in the claim. McGill, Inc. v. John Zink Co., 736 F.2d 666 (Fed. Cir. 1984). ZMI, supra at 1576; Tandon Corp. v. U.S. International Trade Com, 831 F.2d 1017, 1021 (Fed. Cir. 1987), Autogiro Co. of America v. U.S., 384 F. 2d 391 (Ct. Cl. 1967).

Sixth, words in a patent claim are given their ordinary meanings absent evidence that the inventor used them differently. D. Chisum, Patents sec. 18.03 at 18-39 (1991); ZMI, *supra*, at 1576.

Expert testimony, or other extrinsic evidence, can be used where the claim language is ambiguous, Tool-O-Matic v. Proma Product-Und Mktg. Gesellschaft m.b.H, 945 F.2d 1546, 1550 (Fed. Cir. 1991), or where it is necessary to interpret a technical term or a word of art. Senmed, Inc. v. Richard-Allan Medical Industries Inc., 888 F.2d 815, 819 n.8 (Fed. Cir. 1989).

B. The '110 Patent.

Because Ahlbrandtt/Enercon concede that Pillar has not practiced the second embodiment of the invention of the patent and because the Court finds that Claim 6 reads on the second embodiment, the Court is required to determine whether Claim 6, properly constructed, also covers the first embodiment of the '110 patent. Ahlbrandtt/Enercon's position with regard to Claim 6 is clear:

> Enercon and Ahlbrandtt concede that Pillar has not practiced the second embodiment of the invention of the patent, but they argue that Claim 6 covers the first embodiment of U.S. Patent No. 4,466,110 and that Pillar does practice that embodiment of Ahlbrandtt's invention.

(Plaintiff's Proposed Findings of Fact and Conclusions of Law ("PPFF"), pp. 15-16).

The critical language in Claim 6 relied upon by Ahlbrandtt/Enercon is found in what has been labelled "g", *supra*. It reads, "in which part of the cooling airflow is passed through said brush electrode." The core of Ahlbrandtt/Enercon's position is that the "brush electrode" referred to in Claim 6 references a "double electrode" formed from two juxtaposed single electrodes such as the brush electrode described in the first embodiment of the '110 patent. Because Claim 6 so reads, the Pillar device infringes on the first embodiment in turn because the Pillar device shows cooling airflow "through" two single juxtaposed electrodes that make up the "brush electrode."

Pillar, on the other hand, argues that the language is clear and unambiguous and requires a finding that the electrode referred to in "g" of Claim 6 describes a hollow electrode, not two single juxtaposed electrodes, that the "specification" uses language to describe the single hollow electrode embodiment of Fig. 2 of the '110 patent, that the prosecution history tells us Ahlbrandtt intended limitation "g" to cover only a single hollow electrode, that Ahlbrandtt abandoned a broad Claim 6 position (which would cover both embodiments), and, finally, that the German patent application, upon which the '110 patent is based, claimed the single hollow electrode that is found only in Fig. 2. Since Pillar does

not manufacture the device found in Fig. 2, and since Ahlbrandtt/Enercon concede the point, there is no infringement. The Court addresses these arguments in order.

1. Language of the Patent.

Does the "brush electrode" language in "g" speak only to the hollow single brush electrode referred to in Fig. 2 of the patent? Or, does "brush electrode" refer to a double electrode as represented in Fig. 1 of the patent?

The Court first concludes that the drawing in Fig. 2 is one which depicts a single hollow electrode. The space in the middle of the electrode designated "30" on the drawing in Fig. 2 is blank, *i.e.*, there is no cross hatching in the space to represent a solid. On this point, Ahlbrandtt/Enercon concede the following; this "suggests that the electrode may be hollow." (PPFF pp. 28-29)(emphasis added). This concession, however, goes only so far, for "[t]he written description is silent as to any hollowness, or any access to the interior of the electrode ...." *(Ibid.)* The evidence at trial established that blank spaces on a drawing represent empty spaces.[10] Fig. 2 depicts a single hollow electrode.

Secondly, the term "brush electrode" in Claim 6, on its face, is singular in form, for Claim 6 does not contain a definition of brush electrode. Where the term brush electrode is used in the singular, and, indeed, is found as a singular electrode in the second embodiment of the patent, logic dictates that the term be accepted as single electrode where it goes unexplained. From this cursory analysis it appears that where the term "brush electrode" is used without modification, it is meant to be read in the singular.[11]

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[10] See Trial Tr. p.275, ll. 2-20, wherein Ahlbrandt/Enercon's witness Louis Rosenthal agreed that the brush electrode in the second embodiment was hollow.

[11] See Rosenthal's testimony (Trial Tr. pp. 226-227) agreeing that the use of the term "electrode" means a single electrode.

In addition, if the term "brush electrode" in "g" was meant to refer to double electrode, it would have been very easy to add the definitive language of Claim 1, *i.e.*, "in which the brush electrode is a double electrode formed from two juxtaposed single electrodes," to Claim 6. (But, of course, if that language were included, it would not read on Fig. 2 of the patent.) Alternatively, the language of Claim 6 could have been modified to "in which the brush electrode may also be a double electrode formed from two juxtaposed single electrodes." Without this language, Enercon's effort to define the term "brush electrode" in Claim 6 as a double electrode fails.

The position that the term "brush electrode" when used in the patent means a brush electrode comprising a single electrode, unless explained differently, is supported by further analysis of the specifications in the patent. While the term "brush electrode" under the "Background of the Invention" section[12] may be applied to both embodiments, attempts are clearly made to differentiate "brush electrode" in the two embodiments under the "Summary of the Invention" section. Thus, under "Summary of the Invention," a brush electrode in the first embodiment of the invention is first defined. Col. 2, II. 21-23, states, "the brush electrode is a double electrode formed from two juxtaposed single electrodes ...."

Under "Summary of the Invention," col. 2, II. 64-65, describes the second embodiment of the invention (represented by Fig. 2[13])

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[12] "Background of the Invention," col. 1, l. 10, speaks of "at least one facing brush electrode having a quartz coating . . . ." (emphasis added). Col 1. II. 29-31, then state that "the efficiency of such apparatus can be significantly increased if a good cooling of the active discharging side of the brush electrode is ensured." (emphasis added).

Col. 1, II. 20-22, speaks of "the electrical conductivity of he quartz coating of the brush electrode increases with increasing quartz temperature." (emphasis added).

[13] The "Brief Description of the Drawings" section of col. 3, II. 39-48, of the '110 patent reads as follows: "The invention will now be further described, by way of example, with reference to the accompanying diagrammatic drawing, in which: FIG. 1 is a cross-section through the operationally important part of a first embodiment of an apparatus according to the invention; and FIG. 2 is a cross-section through the operationally important part of a second embodiment of an apparatus according to the invention." (emphasis added).

as follows: "[T]he brush electrode has a rectangular cross-section and the first electrode guiding the articles to be treated has a planar surface which guides the articles and faces said brush electrode." Here, clearly, while the term "brush electrode" is used, it is not a brush electrode that is made of "a double electrode formed from two juxtaposed single electrodes." Here brush electrode refers to a single electrode.

Thus, analysis of the "Background of the Invention, Invention," and "Brief Description of the Drawings" sections of the patent suggests that "brush electrode" means either a single electrode embodiment or a double electrode embodiment depending on whether or not it is so characterized or referenced. This appears to be the fundamental definitional effort made to this point in the patent relative to the meaning of "brush electrode."

Therefore, when the language under "Summary of the Invention," col. 3, II. 23-25, referencing the second embodiment, states, "The cooling of the brush electrode is further improved if part of the cooling air flow is passed through said brush electrode," it must be accepted (because Fig. 2 is a "cross-section through the operationally important part of [the] second embodiment") that the reference here is made to part of the cooling air passing through the longitudinal empty space within the single electrode. The language "part of the cooling airflow is passed through said brush electrode" from col. 3, II. 24-25, is the same as the disputed language from Claim 6. Where language is defined at one point in the patent, and later identical language is left undefined without any existing alternative definition, it is logical to apply the definition given to the earlier language to the latter.

If the analysis were to stop here, one would have to say that Claim 6 reads on the second embodiment and not on the first. While the "Summary of the Invention" language, such as at col. 2,II. 34-39, speaks of "single electrodes" "being well cooled ... through circulating the maximum cooling air through the area in which the heat to be removed is formed," it does not fit the above definition of "air passing through the brush electrode." (emphasis added).

While it is argued that the action of the air between the single electrodes comprising the brush electrode in embodiment 1 is "air passing through the brush electrode," it is not specifically defined as such at this point by the patent. On the other hand, that same air action between the single electrodes is already described in the "Summary of the Invention" section at col. 1, II. 60-63, where the air is described as "flow[ing] directly through the discharging area" and, as already mentioned, it is found in col. 2, II. 37-39. Nowhere is it, however, actually described as air flow through the brush electrode.

In addition, as one proceeds through the patent to the "Description of Preferred Embodiments" section, support is found once again for the conclusion that "g" of Claim 6 reads only on the second embodiment.

Nowhere in this section is there specific language speaking of "air", in reference to the two juxtaposed single electrodes, as "air passing through the brush electrode." Ahlbrandtt/Enercon argue that col. 4, II. 42-49,[14] clearly describes the passage of air "through" the Fig. 1 type of brush electrode. However, the more reasonable interpretation of this language is that it describes the flow of air "past" or "by" the single electrodes as it "flows past the active discharging side of the electrodes." It is only in the language describing Fig. 2 and the single and hollow electrode in the "Description of Preferred Embodiments" section that we again meet the language (it was found in the "Summary of Invention"

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[14] "For the correct cooling of the electrodes 3 and 4, it is important that between them there is a free air intake cross-section into the pipe 5 which is greater than the sum of the free cross-section between the electrodes 3, 4 and the insulators 15, 16. As a result, a considerably [sic] proportion of the air flows past the active discharging side of the electrodes 3, 4 into the air exhausting side of the electrodes 3, 4 into the air exhausting pipe 5, as illustrated in the drawing by arrows 26,27."

section describing Fig. 2, *supra*) similar to that in Claim 6, where air is described as passing "through" the brush electrode.[15]

When the language of the patent in this section speaks of passing through the brush electrode, it is not speaking of air passing "past" or "by" two single electrodes making up a brush electrode. This is clear because the language calls for "some other cooling medium" passing "through the brush electrode." No other cooling medium was described in the evidence except air to cool the outside of or discharging surface of an electrode. Further, only air was described as passing through the corona of a brush electrode. The only "other cooling medium" discussed was water, and it can only be passed through the hollow portion of the brush electrode found in Fig. 2. See Trial Tr. p. 921,II. 1-13, for Ahlbrandtt's use of water in this way.[16]

The "passed through it" language found in col. 5, I. 34, under the "Description of Preferred Embodiments" section, and its required definition, does not support Ahlbrandtt/Enercon's position that the same language found in Claim 6 means passing through the two single electrodes comprising the one brush electrode defined in Claim 1. With the patent describing "through the brush electrode" in the "Summary of the Invention" and "Description of Preferred Embodiment" sections in this manner, Ahlbrandtt went on to claim the following in Claim 1.

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15 The pertinent language states, "The drawings do not show that for further cooling of the brush electrode 30 [the single hollow electrode], a partial air flow or some other cooling medium can be passed through it." (col 5, II. 31-34) (emphasis added).

16 The fact that only a hollow electrode could accommodate this form of cooling supports the conclusion by the Court, *supra*, that the second embodiment in Fig. 2 represents a hollow electrode.

I claim:

1. Apparatus for treating the surface of materials by electric brush discharge, said apparatus comprising a first electrode for guiding articles to be treated and at least one facing brush electrode having a coating, which can be connected to opposite potential and is arranged to be cooled by a cooling air flow flowing over the outside thereof, wherein guide means are provided for guiding the cooling air flow at least partly through the corona along the active discharging side of said brush electrode, and in which the brush electrode is a double electrode formed from two juxtaposed single electrodes and in which an air exhausting pipe is provided, said single electrodes forming part of a wall of said air exhausting pipe and air inlets being formed between the said brush electrodes and between said electrodes and the sides of said air exhausting pipe the cross-section of the air inlet between said brush electrodes being larger than the cross-sections of the air inlets located between the brush electrodes and the longitudinal sides of said air exhausting pipe.

And in Claim 6, Ahlbrandtt claimed the following:

6. Apparatus for treating the surface of materials by electric brush discharge, said apparatus comprising a first electrode for guiding materials to be treated and, at least one facing brush electrode having a coating, which can be connected to opposite potential and is arranged to be cooled by a cooling air flow flowing over the outside thereof, wherein guide means are provided for guiding the cooling air flow at least partly through the corona along the active discharging side of said brush electrode, in which said brush electrode has a discharging surface facing said first electrode, and the first electrode guiding the material to be treated has a surface which guides the material and faces said brush electrode, and in which part of the cooling air flow is passed through said brush electrode.

As already shown, Claim 1 clearly defines "brush electrode" as being a double electrode formed from two juxtaposed single electrodes. An effort was made to precisely characterize what was

meant by brush electrode for purposes of describing the apparatus that is found in Claim 1, and in Claims 2, 3, 4 and 5.

No such similar effort was made with regard to Claim 6 that ties it to Claim 1. As previously discussed, "brush electrode" is presumed to be singular unless otherwise described, and the failure to describe, incorporate, define, or reference "brush electrode" as other than a single electrode brush electrode means the presumption holds.

Further, if the language "air flow is passed through said brush electrode" meant it is passed "past" the sides of 3-4 of Fig. 1 which face each other, it would be redundant. Elements "c" and "d" already call for the "air flow flowing over the outside thereof" (c) and "the cooling air flow at least partly through the corona along the active discharging side of said brush electrode" (d). Why would one need to say, in addition to the above, that in addition to the above, that "part of the cooling air passed through said brush electrode," meaning, in effect, it is passed over the outside single brush electrodes 3 and 4 in Fig. 1 where those sides face each other? Also, where the "cooling air flow" flows partly through the corona along the active discharging side of said brush electrode, the language establishes that part of the air, while flowing over the outside of a single brush electrode, will be guided through the corona along the discharge side of each electrode comprising the double brush electrode.

This language standing by itself meets the "primary object" of the invention, which is to "provide means for cooling the active discharging side of a brush electrode." (Col.1, ll. 35-37, "Summary of the Invention.") The "Background of the Invention" section speaks to providing "cooling air flow flowing over the outside" (of at least one brush electrode). (Col. 1, l. 12)(emphasis added). The language calling for "part of the cooling air flow" to go "through said brush electrode" would appear to be excess when applied to Fig. 1 of the '110 patent. If the intent was to create a more clear and specific description of air flow in connection with a double electrode brush electrode as described in Fig. 1, more appropriate language would have been to the effect that "part of the cooling air flow is passed between,

by, or over, the facing sides of single electrodes 3 and 4," particularly in light of the fact that Fig. 2 reflects a hollow single electrode.

Reinforcing this position is the obvious fact that the '110 patent promoted 2 embodiments, and, while the language without doubt reads easily on the 2nd embodiment (because of the prior art and the ordinary meaning of the disputed terms), it requires utilization of rather broad and flexible definitions to say it also applies to the 1st embodiment. Why would such an indirect method be chosen, in drafting the language of the patent, to convey such a critical, yet easily expressed, message? Giving the terms of this patent their ordinary meaning, the answer must be that the critical language of Claim 6 does not apply to the 1st embodiment unless an intent to use them differently is found elsewhere.

At this point, given the foregoing analysis of the general language of the patent and its specifications,[17] only the prosecution history can redeem Ahlbrandtt/Enercon's action. In this regard, Ahlbrandtt/Enercon contend that the prosecution history does indeed demonstrate that Claim 6 was expanded to meet and complement the elements of Claim 1.

2. Prosecution history.

Examination of the prosecution history is undertaken to determine what transpired in an effort to clear up the meaning of Claim 6. Lemelson v. General Mills, Inc., 968 F.2d 1202 (Fed. Cir. 1992); Hughes Aircraft Co. v. U.S., 717 F.2d 1351 (Fed. Cir.1983). Analysis of that history supports the conclusion that language in "g" applies solely to the second embodiment of the '110 patent.

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[17] Reference again is made to the language at col. 5, ll. 31-34, under "Description of Preferred Embodiments," wherein the language similar to that found in "g" can only be applied to Fig. 2nd the 2nd embodiment and to col. 3, ll. 24-26, of the "Summary of the Invention," wherein the exact language of "g" is applied to Fig. 2.

When the '110 application was filed, it had 14 claims. Original Claim 1 claimed the broad concept of forcing cooling air over the outside of a quartz electrode and along the active discharge side:

> 1.Apparatus for treating the surface of articles such as coils, plates, or molded articles by electric brush discharge, said apparatus comprising a first electrode for guiding articles to be treated and at least one facing brush electrode having a quartz coating, which can be cooled by a cooling air flow flowing over the outside thereof, wherein guide means are provided for guiding the cooling air flow at least partly through the corona along the active discharging side of said brush electrode.

The spacing embodiment which is now part of Claim 1 was claimed separately as original Claim 3[18] and reads as follows:

> 3. Apparatus as claimed in Claim 1, in which the brush electrode is a double electrode formed from two juxtaposed single electrodes and in which an air exhausting pipe is provided, said single electrodes forming part of a wall of said air exhausting pipe and air inlets being formed between the said brush electrodes and between said electrodes and the sides of the air exhausting pipe the cross-section of the air inlet between said brush electrodes being larger than the cross-sections of the air inlets located between the brush electrodes and the longitudinal sides of said air exhausting pipe.

Original Claim 12 (which eventually issued as Claim 6) recited:

> 12. Apparatus as claimed in claim 8, in which part of the cooling air flow is passed through said brush electrode.

Original Claim 12 depended from original Claim 8, which recited:

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[18] Original Claim 3 was written as a dependent claim.

8. Apparatus as claimed in Claim 2, in which the brush electrode has a rectangular cross-section and the first electrode guiding the articles to be treated has a planar surface which guides the articles and faces said brush electrode.

(emphasis added).

The way the claims are written, original Claim 8 was meant to cover the basic embodiment shown in Fig. 2, while original Claim 12 was meant to cover part of the cooling air being passed through the hollow electrode shown in the second embodiment. Ahlbrandtt/Enercon agree that Application Claim 12 depended from Application Claim 8, which was dependent on Application Claim 2, which was dependent on Claim 1, and that Claim 12 was originally and specifically limited to cover features shown only in the second embodiment of Fig. 2.

Ahlbrandtt/Enercon suggest, however, that the following history expanded the scope of Claim 6 to include Fig. 1 of the patent. Ahlbrandtt/Enercon argue that after rejecting all of the application claims in the first Office Action, the Patent Office Examiner, in his second Action, indicated that he would allow dependent Application Claim 12, but required that it be redrafted in independent form. After redrafting, the Examiner allowed Application Claim 12. Limitations in Application Claim 12 were then discussed and the Examiner agreed to consider an amendment that Ahlbrandtt/Enercon state broadened Application Claim 12. The amended Application Claim 12 added underlined words and deleted the words in brackets. It looked like this (the claim is again separated for clarity):

12. Apparatus for treating the surface of materials [articles such as coils, plates, or molded articles] by electric brush discharge, said apparatus comprising

a first electrode for guiding materials [articles] to be treated and

at least one facing brush electrode having a [quartz] coating, which can be connected to opposite potential and

is arranged to be cooled by a cooling air flow flowing over the outside thereof,

wherein guide means are provided for guiding the cooling air flow at least partly through the corona along the active discharging side of the said brush electrode,

[in which the brush electrode has a rectangular cross-section]

and the first electrode guiding the materials [articles] to be treated has a [planar] surface which guides the materials [articles] and faces said brush electrode,

and in which part of the cooling air flow is passed through said brush electrode.

The deleted language in Application Claim 12 essentially described only the second embodiment shown in Fig. 2. For example, the detailed description of the second embodiment in the patent provides in col. 5, II. 1-3, "[t]he apparatus shown in FIG. 2 has a simple, box-like brush electrode 30 with a substantially rectangular cross-section." (emphasis added). In the "Summary of the Invention" section, col. 2, II. 63-67, also referring to the second embodiment, states, "According to another embodiment [Fig. 2] of the invention, the brush electrode has a rectangular cross- section and the first electrode guiding the articles to be treated has a planar surface which guides the articles and faces said brush electrode." (emphasis added). Ahlbrandtt/Enercon point out that these deletions, along with the additions, sweep the first embodiment into Claim 6 because the configuration limitations of Fig. 2 are now gone and now include those configurations in Fig. 1. For instance, and by contrast, in the "Description of Preferred Embodiments" section, as to the first embodiment, in col. 3, II. 52-55, the patent states, "FIG 1 shows part of a first electrode constructed in cylindrical manner and which, when the machine is operating, is capable of rotating in the direction of arrow 2." (emphasis added). Also in the first embodiment, the patent in col. 4, II. 1-2, provides, "The single electrodes 3 and 4 have an approximately square cross-section ...." (emphasis added).

Ahlbrandtt/Enercon further argue that the written remarks that accompanied Application Claim 12, as amended, support this conclusion. While the remarks do not expressly address the reason for deleting the limitation "the brush electrode has a rectangular cross-section," the deletion of the word "planar" modifying "the first electrode" is explained as follows:

> And finally, in claims 12 and 13 the word "planar" has been struck. This word may limit these claims to a machine having a flat electrode [as shown in Fig. 2] such that they will not cover a machine which employs a roller-shaped electrode [as shown in Fig. 1].

(emphasis added). Thus, from this Ahlbrandtt/Enercon conclude that the expressed purpose of the amendments to Application Claim 12 was to broaden that claim so that it would not be limited to the features disclosed in the second embodiment shown in Fig. 2, but would include the features found in the first embodiment to the extent that it would now cover the first embodiment shown in Fig. 1.

In making the above argument on the prosecution history, Ahlbrandtt/Enercon must concede that Claim 6, which derived from the original Claim 12, was meant to apply solely to the second embodiment of the patent (Fig. 2). At the time, when Claim 6 applied only to Fig. 2, Ahlbrandtt/Enercon must further concede that the most accurate interpretation of the language "part of the cooling air flow is passed through said brush electrode" is that which claimed that the air passed through the single hollow electrode described in Fig. 2.

Without change in the disputed and critical language of Claim 6, Ahlbrandtt/Enercon must show that the above amendments, which dealt with the "shape" of the different electrodes in Fig. 1 and Fig. 2, were enough to allow the Court to conclude that the critical language was also amended, so that it now applies to a solid double electrode brush electrode as claimed in Fig. 1.

Ahlbrandtt/Enercon's offerings are simply not enough to show that so fundamental a change in meaning occurred.

For example, the Patent Office Examiner rejected original Claim 1, because a patent to Ferrarini (U.S. Pat. No. 4,334,144) "discloses the advantages of cooling the electrodes and suggests circulating cooling air outside the electrodes." (Ex. 503, Paper No. 11, November 24, 1982 at p. 2)(emphasis supplied). The Ferrarini patent disclosed a multiple electrode treater where air flowed "outside the electrodes as well as within the tubes." *(Ibid)*. The Examiner appears to have disallowed claims directed to a broad concept of forcing cooling air between, *i.e.*, over, adjacent electrodes. Narrower claims were accepted corresponding to original Claim 3 (which issued as Claim 1) and original Claim 12 (which issued as Claim 6). (Ex. 503, February 21, 1983 Amendment). This suggests that which was rejected by Ahlbrandtt/Enercon in order to gain acceptance is being reasserted.

Original Claim 1 claimed all embodiments and the concept of simply forcing cooling air over the outside of a quartz electrode and along the active discharge side. This was outlined without the current "spacing" language of then dependent Claim 3. *(See* pp. 20-21, *supra.)* Therefore, element "g" of Claim 6, it appears, cannot be read to mean that the air passes through the space between two single electrodes comprising a brush electrode because such an interpretation would not adequately distinguish it over the claim of Ferrarini.

Neither can the broader interpretation be gleaned from the type of amendments that were made. As was stated earlier, original Claim 8 was meant to cover the basic embodiment shown in Fig. 2, while original Claim 12 was meant to cover an element of original Claim 8, where part of the cooling air was passed through the hollow electrode. The amendments made to Claim 12, which ultimately became independent Claim 6, do not alter this fact.

That is, simply because Ahlbrandtt/Enercon amended Claim 12 to cover some of the features of Fig. 1, does not mean that the claim now covers all of the features of Fig. 1. The "air-through-the-brush electrode" limitation of "g" which is the core of the dispute and for which there is a previously established clear cut meaning, is left untouched. The only conclusion to draw is that while the amendments broadened Claim 12, the scope of limitation "g" remained the same. For while the reasons offered

by Ahlbrandtt/Enercon (for the amendments) in their Application Claim 12 suggest the expansion of coverage to electrodes as shown in Fig. 1, a reasonable interpretation as to the extent of that expansion is that Claim 12 (now Claim 6) now not only covers the hollow, rectangular-shaped planar electrodes of Fig. 2, but could also cover hollow electrodes with different configurations such as those found in Fig 1.

Thus, the more convincing analysis of the amendments is this. The amendments did not alter the meaning of the disputed language in Claim 6; rather, they altered the type of hollow electrode that the unaltered language applies to.

While Ahlbrandtt/Enercon argue that limitations that were not intended by the inventor cannot be read into the patent, neither can the patent be read to expand it beyond the limitations that are present. Since the Court determines that the "g" language was meant to refer to only a hollow electrode, amendments to Claim 6, in order to establish that Claim 6 applied to all brush electrodes, should have reflected a clearer purpose and more definite statement to that effect. The fact that it did not is further evidenced by the written remarks accompanying the amended Application 12.
Ahlbrandtt/Enercon quote the following from those remarks as justification for an expansive reading of the amendments,

> And finally, in claims 12 and 13 the word "planar" has been struck. This word may limit these claims to a machine having a flat electrode (as shown in Fig. 2) such that they will not cover a machine which employs a roller-shaped electrode (as shown in Fig. 1).

(Def. Ex. 503, pp. 70-71.) It goes on to state, "This is an unnecessary limitation in view of the prior art which shows both flat and cylindrical shaped electrodes." *(Ibid.)* (emphasis added).

Thus, these amendments are limited in their scope because they are concerned specifically with "minor" elements of electrode configuration rather than a redefinition of the "g" language. Indeed, Ahlbrandtt/Enercon, in their comments, further support

this limitation by characterizing these amendments as "minor amendments"... which strike unnecessary limitations in the allowed claims" which "do not require re-examination of the merits of the application."[19] Claim 6 does not read on Figure 1 of the '110 patent.

Claim 6 of the '110 patent, as interpreted above, calls for cooling air passing through a brush electrode. As described in the specification and suggested by claim language and the prosecution history, this requires a hollow electrode. Since the accused Pillar treaters are not hollow, they do not literally infringe this claim.

3. "The German application."

Further support for the above conclusion is found in Ahlbrandtt/Enercon's German patent application, which provided the basis for the '110 application. While Ahlbrandtt/Enercon argue that this application has no bearing on the disputed language in the U.S. claim, the German application clearly suggests that the hollow electrode of Fig. 2 was the subject of the language "part of the cooling airflow is passed through brush electrode (30)." (emphasis supplied).

Claim 6 of the '110 double electrode patent originates from dependent Claim 12 of German application 3039051.0, which states:

> 12. Apparatus according to claim 8 or one of the following claims, characterized in that part of the cooling airflow is passed through brush electrode (30).

(emphasis supplied).

Original Claim 8 of the German application from which Claim 12 depends states as follows:

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[19] As indicated earlier, allowance for a type "g" language outside of its application to Fig. 2 of the patent would, it appears, require a re-examination of the merits in light of the Examiner's earlier rejection of the original broad Claim 1.

> 8. Apparatus according to claim 2, characterized in that the brush electrode (30) has a rectangular cross section and the first electrode (32) guiding the articles to be treated has a planar surface which guides the articles and faces electrode 930).

(emphasis supplied).

The Figures in the Ahlbrandtt German priority document are identical to those in the Ahlbrandtt '110 double electrode patent. In both documents, electrode 30 is a large, rectangular hollow electrode which allows air (or perhaps some other medium) to flow through it. The intent that the disputed language was to apply to only Figure 2 in the German application is clear. The fact that the figures in both the German and U.S. applications are identical forces the inference that the meaning of the identical disputed language is the same, that is, it reads solely on Fig. 2 in both applications.

Ahlbrandtt/Enercon have the burden of proving literal infringement by Pillar, *i.e.*, that Pillar, without authority, made, used, or sold the patented '110 invention within the United States during the term of the patent. 35 U.S.C. § 271(a). This must be shown by a preponderance of the evidence. Hughes Aircraft Co v. United States, 717 F.2d 1351 (Fed. Cir. 1983).

The Court's interpretation that Claim 6 clearly calls for at least one electrode wherein cooling air passes through (and not "by" or "past") the electrode, and that this requires a hollow electrode, as described in the specification, dictates the conclusion that the Pillar treaters do not literally infringe this claim. The Court now looks to whether Pillar's treaters infringe under the Doctrine of Equivalents.

THE DOCTRINE OF EQUIVALENTS

An accused device is equivalent to a claimed invention if that device performs substantially the same function in substantially the same way to achieve substantially the same result. Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605 (1950). Because the "hollow electrode" limitation of Claim 6 is missing entirely from the Pillar treaters and because the Court has found

that Claim 6 requires the passage of air through a hollow electrode, Ahlbrandtt/Enercon have failed to show that the Pillar device performed in substantially the same way. Because Claim 6 reads on the second embodiment of the '110 patent, the alleged infringing device is not the substantial equivalent of Fig. 2 of the '110 patent.

Having found for Pillar on the above-stated bases, the Court finds it unnecessary to decide Pillar's claims of invalidity under 35 U.S.C. § 192(b) or its claim of inequitable conduct.

"EXCEPTIONAL CASE"

In addition, Pillar asks the Court to find that this is an "exceptional case." The Court cannot make this finding based on the evidence presented at trial and the analysis just conducted.

NOW, THEREFORE, BASED ON THE FOREGOING IT IS HEREBY ORDERED THAT:

Ahlbrandtt/Enercon's Amended Complaint is **DISMISSED** with prejudice.

Dated at Milwaukee, Wisconsin, this ____ day of June, 1995.

SO ORDERED,

_____

HON. RUDOLPH T. RANDA
U.S. District Judge

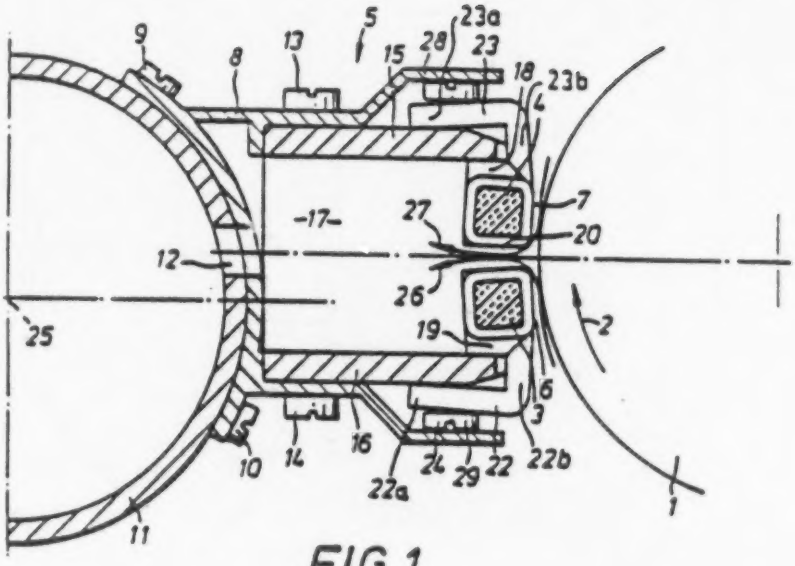

FIG. 1

EXHIBIT
1

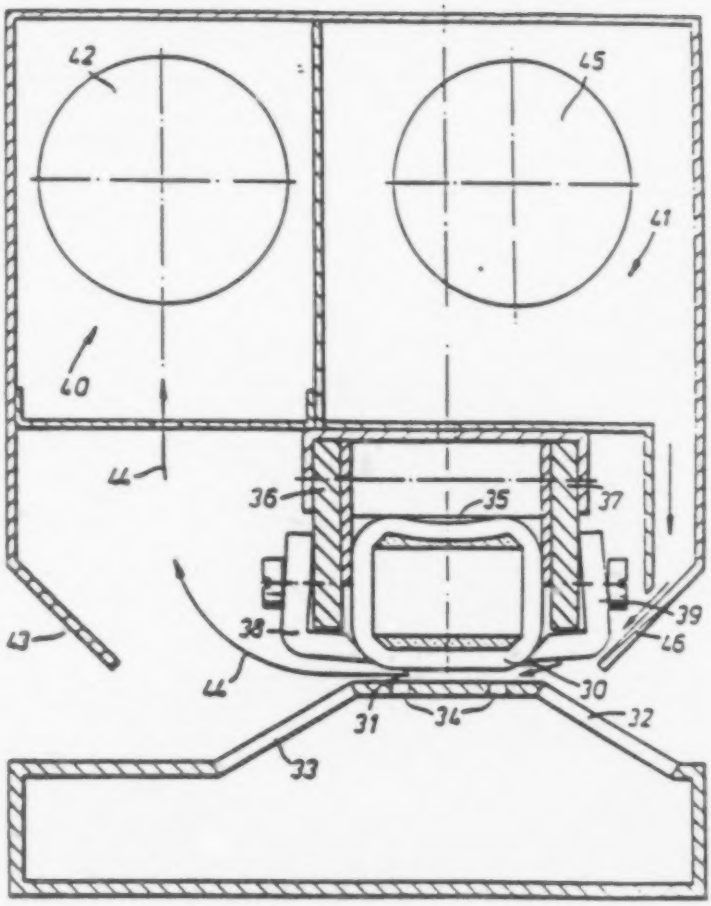

FIG. 2

EXHIBIT
2